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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,318	02/09/2004	Shinichi Sato	248740US2	6645
22850	7590	08/14/2006	EXAMINER	
C. IRVIN MCCLELLAND			MAI, ANH T	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			ART UNIT	PAPER NUMBER
1940 DUKE STREET				
ALEXANDRIA, VA 22314			2832	

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/773,318	SATO ET AL.	
	Examiner	Art Unit	
	Anh T. Mai	2832	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 June 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6, 13-17 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 27-31 is/are allowed.
- 6) Claim(s) 1,3-6, 12, 14-17 is/are rejected.
- 7) Claim(s) 2,14, is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-5, 13, 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito [JP07037712].

Ito discloses an inductive element having a first direction, a second direction, and a stacking direction [XYZ coordinate] said inductive element comprising: a plurality of alternating individual sheets of conducting 2 and insulating layers 3 forming a stack wherein each conducting layer is integrally formed from a solid sheet into a U-shaped conductive layer such that every U-shaped conductive layer is located in a substantially same position along the first direction [X direction] and the second direction [Y direction] and is located a distance from an adjacent U-shaped conductive layer along the stacking direction [Z direction]; an embedding material 6 filled in an area between legs of the U-shaped conducting layers; a bridge conductor 5 which bridges an opening edge of the U-shaped conducting layer to an opening edge of the next U-shaped conducting layer to form a coil [see figures 1-2; abstract].

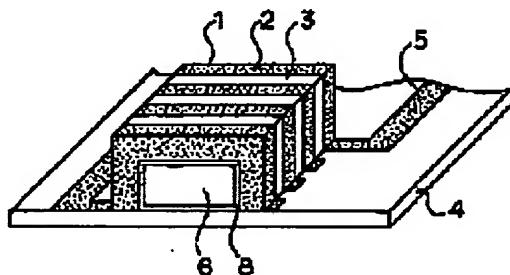
With respect to claim 3, insulating layer made of SiO₂.

With respect to claims 4 and 17, the U-shaped conducting layers are made of Cu plate [metal plate]. With respect to limitation "bridge conductor is formed by photolithography method" has been considered but not given any patentable weight. "Even though product-by-process

claim are limited by and defined by the process, determination of patentability is based process on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964 (Fed cir. 1985)

With respect to claim 5, the bridge conductor is formed on a flatten surface of both an opening edge of U-shaped conducting layers and embedding material embedded in the area.

With respect to claim 15, the U-shaped conductor having the same sizes and located adjacent to each other along staking layer direction connect each other by bridge connectors [figure 2].



Allowable Subject Matter

3. Claims 27-31 are allowed.
4. Claims 2 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2 and 14 recite, *inter alia*, *the U-shaped conducting layers (conductors) are connected by said bridge conductor by skipping one of said U-shaped conducting layers (conductors) so as to form two sets of rectangular helical coils.*

Claim 27 recites *inter alia*, *a bridge conductor which bridges the U-shaped conducting layers by skipping one of said U-shaped conducting layers to form two sets of rectangular helical coils*.

The references of record do not teach or suggest the aforementioned limitation, nor would it be obvious to modify those references to include such limitation.

Response to Arguments

Applicant's arguments with respect to claims 1-6, 13-17, 27-31 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh T. Mai whose telephone number is 571-272-1995. The examiner can normally be reached on 5/4/9 Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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